

REMARKS

By this amendment, claim 1 is amended, claims 2 and 4 are canceled, and claims 6-13 are added to place this application in condition for allowance. Currently, claims 1, 3, and 5-13 are before the Examiner for consideration on their merits.

Claim 1 has been amended to more clearly define the continuous line as undulating along the x-axis on a plane like a sine curve. This can be seen in Figure 3.

Claim 6 and its dependent claims are added to define the continuous line as undulating on the x-axis with an s-shape or an inverted s-shape, see Figure 7.

Claims 10 and 11 are added to more clearly define that the adhesive follows or encircles the entire periphery of the elastic member when forming the claim shape of the sine curve or s-shape or inverted s-shape.

Claims 12 and 13 are added to define the height as being greater than the circumferential length of the elastic member.

Turning now to the Office Action, the Examiner relies principally on two references to reject the claims. Claims 1-3, and 5 are rejected under 35 U.S.C. § 102(e) based on United States Patent No. 6,235,137 to Van Eperen et al. (Van Eperen). Claims 1-5 are also rejected under 35 U.S.C. § 102(e) based on United States Patent No. 6,200,635. The arguments in favor of the patentability of the pending claims are set forth below by the Invention and prior art reference headings.

INVENTION

The invention addresses the problem of insufficient bonding of string-like members to sheet material during the manufacture of disposable articles and the like. While bonding can be increased by increasing the area that adhesive is applied to the sheet, increasing the adhesive area can reduce the flexibility of the sheet material.

Applying the adhesive intermittently to the string-like member is also problematic since the portion of the string-like member containing the adhesive may not always contact the sheet material, thus compromising the effect of the adhesive.

The invention solves this problem by applying the adhesive to an elastic member in such a way that the elastic member is better secured to the sheet material.

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KWOK

Claim 1

In the Office Action, the Examiner alleges that Kwok teaches all of the steps of claim 1. Notably absent from the Examiner's reasoning is the basis for the limitation that the height of the undulation is "substantially equal to or greater than a circumferential length of the elastic member." The Examiner fails to even address this limitation in the rejection, and without setting forth an objective basis in fact to support the rejection, the rejection is improper for this reason alone.

Nevertheless, Kwok does not teach this aspect of the invention. As is clear from Figures 3 and 4, Kwok lays the adhesive 24 on the top of the elastic member 70. Applicants contend that with this overlaying process, the adhesive cannot wrap around the elastic member 70, (portions of the underside are necessarily exposed using the Kwok method) and the undulation of the adhesive cannot be substantially equal to the circumferential length of the elastic member. The claim limitation in question can be best appreciated by reviewing Figure 3 wherein the circumferential length is represented by the distance between m and -m. The sine curve is shown with a height that is at least equal to or greater than the circumferential distance between m and -m. Lacking this claim limitation, the Examiner cannot assert that Kwok anticipates claim 1, and the rejection based on 35 U.S.C. § 102(e) is flawed and must be withdrawn.

While the Examiner could assert that it would be obvious to increase the length of adhesive applied to the elastic member of Kwok so that it would be equal to or greater than the circumferential length of the elastic member, the Examiner must have a reason for such an assertion. However, there is plainly no reason to do so. Any allegation that this would be an obvious modification of Kwok can only be the blatant hindsight reconstruction of the prior art using Applicants' disclosure as a road map to such a change. Since this practice is forbidden in patent law, there is no legitimate reason to arrive at the invention based on Kwok, and the Examiner cannot allege that Kwok establishes a *prima facie* case of obviousness.

Kwok is further distinguished from claim 1 in that it does not teach applying the adhesive so as to form a sine curve. In Kwok's own words, the pattern is an omega pattern, see col. 5, lines 25-35. An omega pattern is not the same as the claimed sine curve, and Kwok cannot anticipate claim 1 for this reason as well.

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Moreover, there is no reason to alter the omega-shaped pattern of Kwok into a sine curve pattern, since there is no teaching or suggestion to do so. Again, any allegation that it would be obvious to use a sine curve pattern for the omega-shaped pattern of Kwok is the impermissible use of hindsight. If anything, Kwok teaches away from such a modification by specifically using the omega-shaped pattern for the adhesive, and failing to teach that it could be replaced with another type.

Claim 6

Claim 6 is similar to claim 1 except for the fact that the undulations are defined in terms of an s-shape or an inverted s-shape. This shape can be seen in Figures 6 and 7. The same arguments are made for claim 6 as for claim 1 regarding the height of the undulation as compared to the circumferential length of the elastic member, and claim 6 is distinguishable from Kwok for this reason.

Claims 10 and 11

Claims 10 and 11 are also distinguishable from Kwok on the basis that Kwok does not encircle the elastic element when applying the adhesive. In contrast, Kwok merely lays the adhesive on the top of the elastic element, draping the sides at best, but clearly not encircling the member. Therefore, Kwok cannot anticipate claims 10 and 11. In addition, there is no reason to alter Kwok and allege that it would be obvious to have the adhesive follow the periphery of the elastic member without resort to hindsight. In fact, Kwok would teach away from such a modification given its teachings regarding the manner in which the adhesive is applied, see Figures 3 and 4.

Claims 12 and 13

Kwok also fails to teach the limitations of these claims in that the continuous adhesive line does not have a height in its developed plane that is greater than the circumferential length of the elastic member. Further, there is no reason to alter the omega shape of Kwok to generate such a height, and there is no basis to reject these claims under 35 U.S.C. § 103(a).

In light of the above, Kwok cannot establish a *prima facie* case of anticipation or obviousness against claims 1, 6, and 10-13, and the rejection based on this reference must be withdrawn.

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VAN EPEREN

Claim 1

Van Eperen also fails to establish a *prima facie* case of anticipation or obviousness against claim 1. As argued above, claim 1 defines the continuous line as having a height substantially equal to or greater than a circumferential length of the elastic member when viewed in a developed plane, see Figure 3 again. While Van Eperen arguably teaches a sine curve shape of the adhesive, this shape when developed on a plane matching the circumferential length of the elastic member does not approach the circumference, and cannot be considered to be substantially equal to or greater than as now claimed. Lacking this limitation, the anticipation rejection must be withdrawn.

Moreover, there is no reason why one of skill in the art would modify the shape of the adhesive of Van Eperen since there is no reason to do so. Any allegation by the Examiner that it would be obvious to change the shape of the Van Eperen is the application of hindsight. In fact, there is no basis for the Examiner to conclude that it would be obvious to increase the length of the adhesive as applied to the elastic member and achieve the claim limitation regarding the length of the undulation in the developed plane.

Claim 6

Claim 6 is patentable over Van Eperen for the same reason that claim 1 is patentable. Moreover, claim 6 is also distinct from Van Eperen since Van Eperen does not teach the use of an s-shape or inverted s-shape adhesive line on the elastic member. Lacking this limitation, Van Eperen cannot anticipate claim 6.

In addition, there is no reason to conclude that claim 6 is obvious over Van Eperen since there is no teaching to alter the adhesive shape of Van Eperen and make it like the claimed s-shape or inverted s-shape.

Claims 10-13

As with Kwok, Van Eperen does not teach or suggest the feature that the continuous line encircles the entire periphery of the elastic member. It is obvious from the drawings of Van Eperen that the adhesive is laid or draped on the elastic member (similar to Kwok), and it does not encircle the entire periphery.

Similarly, Van Eperen fails to teach the features of claims 12 and 13 and a curve in a

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developed plane that has a height greater than the circumferential length of the elastic member.

SUMMARY

Neither Kwok nor Van Eperen establishes a *prima facie* case of anticipation or obviousness against claims 1, 6, and 10-13. Therefore, each of these claims is patentably distinguishable from the cited prior art. Moreover, dependent claims 3, 5, and 7-9 are also in condition for allowance by reason of their dependency on their respective independent claims.

Accordingly, the Examiner is respectfully requested to examine this application in light of this amendment, and promptly pass claims 1, 3, and 5-13 onto issuance.

If the Examiner believes that an interview would expedite allowance of this application, the Examiner is invited to telephone the undersigned at 202-835-1753.

The above constitutes a complete response to the Office Action dated March 22, 2004.

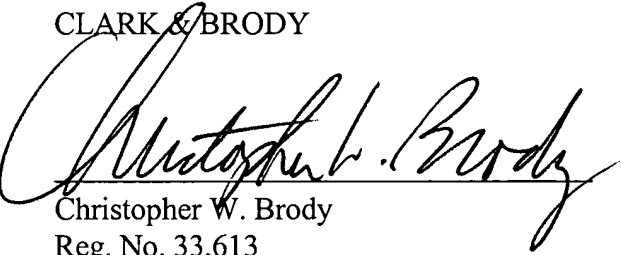
Again, reconsideration and allowance of this application is respectfully solicited.

Please charge deposit account no. 50-0188 for any shortages in fees in connection with this filing, and credit any overpayments as well.

Respectfully submitted,

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